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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,269	03/04/2002	Akira Miyata	02131/LH	6423

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
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NEW YORK, NY 10001-7708

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p align="center">10/091,269</p>	<p>Applicant(s)</p> <p align="center">MIYATA ET AL.</p>	
	<p>Examiner</p> <p align="center">Thierry L. Pham</p>	<p>Art Unit</p> <p align="center">2625</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|--|---|

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DETAILED ACTION

- This action is responsive to the following communication: Nonprovisional application filed on 3/4/02.
- Claims 1-19 are pending.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 9-11, 17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

Programs as cited in claim 9-11, 17-18 are directed to a non-statutory subject matter. The examiner recommends the applicants to amend the claims containing the following language "computer readable medium" so it compliances with 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Is service device and server device the same or different? Clarification is required. The Examiner herein interprets both devices are the same (e.g. server device).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 8-15, 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al (US 6975421).

Regarding claim 1, Hashimoto discloses a printing service system (printing system, fig. 1) comprising:

- a service device (printer 30 also serve as a web server, fig. 1, col. 10, lines 40-67) which comprises a storage portion (hard disk 34, fig. 1) having a main image and a thumbnail image stored (store both main image and thumbnail image, fig. 5-6, col. 3, lines 55-67) therein;
- a portable information device (client terminal 40, fig. 1) which provides access to the server device via a network (network W, fig. 1) to receive a desired thumbnail image and its number (thumbnail image and its number, fig. 5-6, wherein thumbnail image

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represents actual print data stored in hard disk 34) from the storage device, and transmits the image number to a printing device (printer engine 38, fig. 1), corresponding to the thumbnail image; and

- a printing device (printer engine 38, fig. 1) which downloads (downloads from hard disk 34 to printer engine 38, fig. 1) and prints the main image (actual print data, fig. 3) which corresponds to the thumbnail image (fig. 5-6) specified from the portable information device from the server device via the network.

Regarding claim 2, Hashimoto further discloses a printing service system according to claim 1, wherein the portable information device further comprises a display portion (display portion 45, fig. 1) to display the thumbnail image and an input portion for (input portion 46, fig. 1) a user to input a command.

Regarding claim 3, Hashimoto further discloses a printing service system according to claim 1, wherein the portable information device further comprises a storage portion (memory 44, fig. 1) which stores a thumbnail image and a display portion to display a thumbnail image.

Regarding claim 4, Hashimoto further discloses a printing service system according to claim 1, wherein the server stores the main image, thumbnail image, and image number (figs. 5-6 & 14-15, col. 5, lines 10-15) in the storage device in association therewith.

Regarding claim 8, Hashimoto discloses a server device (printer 30 also serve as a web server, fig. 1, col. 10, lines 40-67) comprising:

- a first storage portion (hard disk 34, fig. 1) having stored therein a main image and a thumbnail image corresponding to the main image (figs. 5-6, col. 3, lines 55-60);
- a second storage portion (ROM 32, fig. 1) having a program stored therein;
- a communication portion (I/F 37, fig. 1) connected to a network (network W, fig. 1) to connect an external device (PC 40, fig. 1); and

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- a control portion (CPU 31, fig. 1) which reading out the thumbnail image specified via the network from the first storage portion in accordance with a program stored by the second storage portion, followed by delivering the read out image (figs. 5-6) from the communication portion to an external device via the network, and reads out the main image (reads out actual print data, figs. 14-15) presented via the network (network W, fig. 1) from the first storage portion, followed by delivering the read out image from the communication portion to the external device (PC 40, fig. 40) via the network.

Regarding claim 9, Hashimoto discloses a service device program comprising: a step of transmitting a thumbnail number and an image number (figs. 5-6) that corresponds thereto upon an external request via a network (network W, fig. 1); a step of externally receiving the image number (input command request, col. 5, lines 50-55) that corresponds to the thumbnail image via the network; and a step of externally delivering a larger amount (reads out actual print data, figs. 14-15) of data than that of a thumbnail, the image corresponding to the received image number via the network.

Regarding claim 10, Hashimoto discloses a portable information device program comprising: a step of providing access (access via network W, fig. 1) from a portable information device (pc 40, fig. 1) to a printing device (printer 30, fig. 1) by a user operation; a step of causing a user to select (select thumbnail as shown in fig. 5-6) a stored thumbnail; and a step of delivering the image number (figs. 5-6) that corresponds to the thumbnail to the printing device.

Regarding claim 11, Hashimoto further discloses a portable information device program according to claim 10, further comprising a step of disconnecting a network (disconnecting via I/F 47, fig. 1 or fig. 7).

Regarding claims 12 & 19, Hashimoto discloses a printing service system (printing system, fig. 1) comprising:

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- a server device (printer 30 also serve as a web server, fig. 1, col. 10, lines 40-67) which comprises a storage portion (hard disk 34, fig. 1) having a main image and a thumbnail image stored therein, the server device externally delivering the main image and thumbnail image and an image number (store both main image and thumbnail image, fig. 5-6, col. 3, lines 55-67);
- a portable information device (client terminal 40, fig. 1) which provides access to the server device via a network (network W, fig. 1), thereby receiving a desired image number from the storage portion and transmitting the image number to the server device (thumbnail image and its number, fig. 5-6, wherein thumbnail image represents actual print data stored in hard disk 34); and
- a printing device (printer engine 38, fig. 1) which downloads and prints the main image from the server device (downloads from hard disk 34 to printer engine 38, fig. 1) via the network in accordance with a command from the server.

Regarding claim 13, Hashimoto further discloses a printing service system according to claim 12, wherein the portable information device comprises: a display portion (display portion 45, fig. 1) to receive a thumbnail image and number from the server, and further, to display the thumbnail image; and an input portion (input portion 46, fig. 1) for a user to select the thumbnail image.

Regarding claim 14, Hashimoto further discloses a printing service system according to claim 12, wherein the portable information device further comprises a storage portion (memory 44, fig. 1) which stores an image number and a display portion to display a thumbnail image.

Regarding claim 15, Hashimoto further discloses a printing service system according to claim 12, wherein the server stores the main image and thumbnail image and number (figs. 5-6 & 14-15, col. 5, lines 10-15) in the storage portion in association therewith.

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Regarding claim 17, Hashimoto discloses a portable information device program comprising: a step of providing access (access via network W, fig. 1) from a portable information device (pc 40, fig. 1) to a server (printer 30, fig. 1) via a network by a user operation; a step of displaying image data delivered from the server; a step of causing the user to select (select thumbnail as shown in fig. 5-6) a desired image from the displayed image; a step of prompting the user to deliver a print command (print command as shown in figs. 5-6) to the server; and a step of causing the user to select a printer (col. 10, lines 55-67) targeted for printing.

Regarding claim 18, Hashimoto further discloses a portable information device program according to claim 17, further comprising a step of disconnecting a network (disconnecting via I/F 47, fig. 1 or fig. 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto as described in claim 1 above, and in view of Kato et al (US 5956557).

Regarding claims 5-7, 16, Hashimoto discloses a printer comprising: a communication portion, control portion, and printing portion, but fails to teach and/or suggest a coin charge portion which receives a coin.

Kato, in the same field of endeavor for printing, teaches a well-known example of a printer having a coin charge portion (coin-operated image forming apparatus as shown in fig. 1, abstract, col. 10, lines 60-67). In other words, fees for service copy machine and/or printer is well known and widely used in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify image forming apparatus of Hashimoto to include a coin

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charge portion for charging users/operators fees (costs associated with print materials) of using printer to print out documents as taught by Kato.

Therefore, it would have been obvious to combine Hashimoto with Kato to obtain the invention as specified in claims 5-7, and 16.

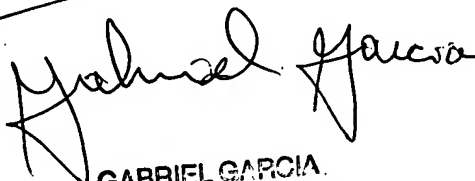
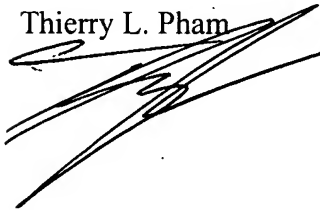
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER